

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks. Claims 1-38 are pending in the present application of which Claims 1, 12, 21 and 30 are independent.

Drawings and Information Disclosure Statement

At the outset, the indication that the Drawings and Information Disclosure Statement filed on January 8, 2002 have been respectively accepted and considered is noted with appreciation.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of Claims 1-5, 7, 12-14, 20-22, 28-32 and 38 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in U.S. Patent Application No. 2001/0003823 to Mighdoll et al. This rejection is respectfully traversed because Mighdoll et al. fails to disclose the claimed invention as set forth in Claims 1, 12, 21 and 30.

Mighdoll et al. pertains to a method for downloading a web page. Mighdoll et al. discloses that the client requests a single web page from a server for display on a television screen. The server lays out the web page into partitions corresponding to a viewable display area of the television screen. The server then downloads all of the image data for the viewable area such that the portion of the web page within the viewable area can be fully generated and displayed to the client in a reduced amount of time. See Abstract.

The Official Actions asserts that Mighdoll et al. discloses all the elements of Claims 1, 12, 21 and 30 of the present invention, but does not teach the “most-recently-visited” or “most-likely-to-be-visited” storage areas. It is respectfully submitted, however, that Mighdoll et al. fails to disclose these and other elements of Claims 1, 12, 21 and 30 of the present invention.

With regard to Claim 1, Mighdoll et al. does not disclose, for instance, “a number-of-pages-to-be-loaded variable storage area” or “wherein said processor uses...said number-of-pages-to-be-loaded variable storage area in order to fetch and/or store two or more display pages to said display pages storage area in response to a single user input without waiting for a user to select additional pages to view on said display device.” With regard to Claims 12 and 30, Mighdoll et al. also does not disclose, for instance, the step of “obtaining a predetermined number-of-pages-to-be-loaded variable” or “pre-fetching a predetermined

number of display pages as set by said predetermined number-of-pages-to-be-loaded variable.” With regard to Claim 21, Mighdoll et al. also does not disclose, for instance, the step of “obtaining a predetermined number-of-pages-to-be-loaded variable” or “obtaining a predetermined number of display pages as set by said predetermined number-of-pages-to-be-loaded variable.”

¶ The Official Action asserts that because the requested web page of Mighdoll et al. is partitioned into a plurality of partitions, it discloses the above-cited elements of Claims 1, 12, 21 and 30. The Applicants respectfully disagree. ¶ Mighdoll et al. does not disclose a number-of-pages-to-be-loaded variable storage area or the downloading, pre-fetching or obtaining of two or more display pages. }

¶ In addition, because Mighdoll et al. discloses a method of downloading only a single web page requested by a user and not multiple pages at once, there is absolutely no reason Mighdoll et al. would include a number-of-pages-to-be-loaded variable storage area or would download pages not requested by a user. In fact, Mighdoll et al. does not disclose any method for downloading a page or portion of a page not requested by a user. }

At least by virtue of Mighdoll et al.’s failure to disclose the above-identified elements of Claims 1, 12, 21 and 30, the Official Action has failed to establish that Claims 1, 12, 21 and 30 of the present invention are rendered obvious under 35 U.S.C. § 103. More particularly, the Official Action has failed to establish a *prima facie* case of obviousness at least because Mighdoll et al. fails to teach or suggest all the claim elements. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1, 12, 21 and 30.

The Applicants respectfully submit that the rejection under 35 U.S.C. § 103 over Mighdoll et al. is improper because the Official Action fails to provide a motivation for

modifying Mighdoll et al. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." In re Mills, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Also See MPEP §2143.01. In this case, the Official Action has failed to provide a second reference or any other prior art that would show motivation to modify Mighdoll et al. as suggested in the Official Action. Therefore, the first test of obviousness has not been satisfied.

Even assuming for the sake of argument that the 35 U.S.C. § 103 rejection is considered proper, the Applicants submit that there is no motivation in Mighdoll et al. to modify Mighdoll et al. to achieve the present invention. The Applicants respectfully submit that the motivation to modify a reference to perform a substantially different function not disclosed therein, cannot, by definition, be found within itself. There must be some suggestion or teaching in the prior art to combine or modify a reference. If only a single reference is used, that reference teaches the subject matter of its disclosure and, by definition, cannot teach a modification of the disclosure to achieve a substantially different function than that intended by the disclosure. Therefore, the Applicants respectfully submit that the Official Action has failed to show a motivation to modify Mighdoll et al.

Furthermore, the Applicants submit that even if the 35 U.S.C. § 103 rejection presented in the Official Action is considered proper and an adequate motivation exists to modify the Mighdoll et al. document, the Official Action has still failed to show that Mighdoll et al., as modified, teaches or suggests all the claim elements as discussed above. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 1, 12, 21 and 30 of the present invention.

For at least the foregoing reasons, Claims 1, 12, 21 and 30 are patentably distinguishable over the disclosure contained in Mighdoll et al. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 1, 12, 21 and 30. Claims 2-11 depend from allowable Claim 1, Claims 13-20 depend from allowable Claim 12, Claims 22-29 depend from allowable Claim 21 and Claims 31-38 depend from allowable Claim 30. Therefore, Claims 2-11, 13-20, 22-29 and 31-38 are also allowable over Mighdoll et al. at least by virtue of their dependencies.

The Official Action sets forth a rejection of Claims 6, 17, 25 and 35 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Mighdoll et al. in view of WO 02/10943 to Davis. The Applicants respectfully submit that Claims 1, 12, 21 and 30 are patentably distinguishable over the disclosure contained in Mighdoll et al. In addition, the disclosure contained in Davis is not relied upon in the Official Action to make up for the deficiencies in the rejection of Claims 1, 12, 21 and 30 of the present invention. Therefore, Claim 6 which depends upon Claim 1, Claim 17 which depends upon Claim 12, Claim 25 which depends upon Claim 21, and Claim 35 which depends upon Claim 30 are allowable at least by virtue of their dependencies upon allowable claims. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 6, 17, 25 and 35.

The Official Action sets forth a rejection of Claims 8-11, 15-16, 18-19, 23-27 and 33-37 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Mighdoll et al. in view of U.S. Patent Application No. 2003/0151651 to Roztocil. The Applicants respectfully submit that Claims 1, 12, 21 and 30 are patentably distinguishable over the disclosure contained in Mighdoll et al. In addition, the disclosure contained in Roztocil is not relied upon in the Official Action to make up for the deficiencies in the

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rejection of Claims 1, 12, 21 and 30 of the present invention. Therefore, Claims 8-11 which depend upon Claim 1, Claims 15-16 and 18-19 which depend upon Claim 12, Claims 23-27 which depend upon Claim 21, and Claims 33-37 which depend upon Claim 30 are allowable at least by virtue of their dependencies upon allowable claims. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 8-11, 15-16, 18-19, 23-27 and 33-37.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

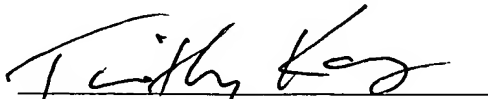
Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

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By


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